

REMARKS

Applicant has amended claims 1, 8-9, 14-18, and 22-25, and canceled claims 1-8, 10-13, 16 and 21 with respect to the present patent application. Applicant is not conceding in the present patent application that these amended and canceled claims are not patentable over the art cited by the Examiner, as the claim amendments and cancellations are only for facilitating expeditious prosecution of the patent application. Applicant respectfully reserves the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

The Examiner rejected claims 14, 15, 17 and 22-25 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

The Examiner rejected claims 9 and 18-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

The Examiner rejected claims 14, 15, 17 and 22-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

Applicant respectfully traverses the § 101, § 102 and § 103 rejections with the following arguments.

35 U.S.C. § 101

The Examiner rejected claims 14, 15, 17 and 22-25 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

The Examiner argues: “Claims 14, 15, 17, and 22-25 are non-statutory because they merely describe the contents of the data stored in the voice prompt database. Because these data contents do not further limit the claimed invention either functionally or structurally, they essentially constitute non-functional descriptive materials that are not capable of producing a useful result, and hence represent only abstract ideas. Therefore, the claims are non-statutory”.

In response, Applicant respectfully contends claim 14 does not “merely describe the contents of the data stored in the voice prompt database” and does not fail to further limit the claimed invention either functionally or structurally.

To the contrary, claim 14 further limits the method step of “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music, and wherein said speaking the first complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern as said music” by reciting “wherein said speaking the first complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern as said music”.

In further response, Applicant respectfully contends claim 15 does not “merely describe the contents of the data stored in the voice prompt database” and does not fail to further limit the claimed invention either functionally or structurally.

To the contrary, claim 15 further limits the method step of “speaking, by the audio apparatus, a first complete message to the telephone caller” by reciting “wherein said speaking the first complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern as said audio tone”.

In further response, Applicant respectfully contends claim 17 does not “merely describe the contents of the data stored in the voice prompt database” and does not fail to further limit the claimed invention either functionally or structurally.

To the contrary, claim 17 further limits the method step of “speaking, by the audio apparatus, a first complete message to the telephone caller” by reciting “wherein said speaking the first complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern as said sequence of beeps”.

In further response, Applicant respectfully contends claim 22 does not “merely describe the contents of the data stored in the voice prompt database” and does not fail to further limit the claimed invention either functionally or structurally.

To the contrary, claim 22 further limits the method step of “speaking, by the audio apparatus, a first complete message to the telephone caller” by reciting “wherein said speaking the first complete message comprises speaking by the first speaker the first complete message consisting of the digital-to-analog converted first bit pattern”.

In addition, claim 22 further limits the method step of “speaking, by the audio apparatus, a second complete message to the telephone caller” by reciting “wherein said speaking the

second complete message comprises speaking by the second speaker the second complete message consisting of the digital-to-analog converted second bit pattern”.

In further response, Applicant respectfully contends claim 23 does not “merely describe the contents of the data stored in the voice prompt database” and does not fail to further limit the claimed invention either functionally or structurally.

To the contrary, claim 23 further limits the method step of “speaking, by the audio apparatus, a first complete message to the telephone caller” by reciting “wherein said speaking the first complete message comprises speaking by the male speaker the first complete message consisting of the digital-to-analog converted first bit pattern”.

In addition, claim 23 further limits the method step of “speaking, by the audio apparatus, a second complete message to the telephone caller” by reciting “wherein said speaking the second complete message comprises speaking by the female speaker the second complete message consisting of the digital-to-analog converted second bit pattern”.

In further response, Applicant respectfully contends claim 24 does not “merely describe the contents of the data stored in the voice prompt database” and does not fail to further limit the claimed invention either functionally or structurally.

To the contrary, claim 24 further limits the method step of “speaking, by the audio apparatus, a first complete message to the telephone caller” by reciting “wherein said speaking the first complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern having the first level of formality”.

In addition, claim 24 further limits the method step of “speaking, by the audio apparatus, a second complete message to the telephone caller” by reciting wherein said speaking the second complete message comprises speaking the second complete message consisting of the digital-to-analog converted second bit pattern having the second level of formality“”.

In further response, Applicant respectfully contends claim 25 does not “merely describe the contents of the data stored in the voice prompt database” and does not fail to further limit the claimed invention either functionally or structurally.

To the contrary, claim 25 further limits the method step of “speaking, by the audio apparatus, a first complete message to the telephone caller” by reciting “wherein said speaking the first complete message comprises speaking by the speaker the first complete message consisting of the digital-to-analog converted first bit pattern in the first wording that conveys said meaning”.

In addition, claim 25 further limits the method step of “speaking, by the audio apparatus, a second complete message to the telephone caller” by reciting “wherein said speaking the second complete message comprises speaking by the speaker the second complete message consisting of the digital-to-analog converted second bit pattern in the second wording that conveys said meaning”.

Accordingly, Applicant respectfully requests that the rejection of claims 14, 15, 17 and 22-25 under 35 U.S.C. § 101 be withdrawn.

35 U.S.C. § 102(b)

The Examiner rejected claims 9 and 18-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

Applicant respectfully contends that Osder does not anticipate claim 9, because Osder does not teach each and every feature of claim 9.

As a first example of why Osder does not anticipate claim 9, Osder does not teach the feature: “receiving commands from a telephone caller”.

The Examiner argues that Osder, col. 8, lines 1-7 teaches the preceding feature of claim 9.

In response, Applicant respectfully contends that Osder, col. 8, lines 1-7 teaches receiving “voice messages from a telephone connection”, but does not teach that the voice messages received from the telephone connection are commands. For example, a voice message from a telephone caller may be “hello” which is not a command, “am I properly connected?” which is not a command, “This is John Doe” which is not a command, etc.

To the contrary, Osder, col. 7, lines 67 teaches that commands are received from software, namely through Application Interface Module (AIM) 30.

Furthermore, Osder, col. 28, lines 1-7 recites: “The SYSTEM Indexed Prompt Table contains prompt names for the prompts required by PEP 13 for ... providing the voice, beep or tone that notifies a caller to begin recording a message”. In other words, Osder teaches the software directing a command to the telephone caller (“notifies a caller to begin recording a message”) and not vice versa.

Applicant respectfully requests that the Examiner cite specific content in Osder allegedly

teaching that the “voice messages from a telephone connection” are commands.

Therefore, Osder does not anticipate claim 9.

As a second example of why Osder does not anticipate claim 9, Osder does not teach the feature: “responsive to said received commands, determining that the voice prompt is needed”.

The Examiner argues that “Osder discloses ... responsive to said received commands, determining that the voice prompt is needed (i.e. "When a Network Application 10 requires that a prompt to be played," col. 7 lines 41-42)”.

In response, Applicant notes that the preceding quote of Osder by the Examiner is incomplete and hence misleading. The complete quote from Osder, col. 7, lines 41-43 is: “When a Network Application 10 requires that a prompt be played, the Network Application issues a PEP command to the agent 16.”

In other words, claim 9 requires that the voice prompt is responsive to the received command. In contrast, Osder teaches that the PEP command is responsive to a determination that a voice prompt is needed, which is the exact opposite of what claim 9 requires.

Therefore, Osder does not anticipate claim 9.

As a third example of why Osder does not anticipate claim 9, Osder does not teach the feature:

“identifying a first database record that includes a digitally encoded voice prompt consisting of a first bit pattern that consists of a first sequence of bits, wherein the bits of the first sequence of bits are stored contiguously in the identified first database record, and wherein said identifying the first database record is implemented through use of the first value which selects

the first database record and specifies the first bit pattern;

performing a first process that generates a first complete message from the identified first database record and speaks the generated first complete message to the telephone caller, said performing the first process consisting of the steps of:

reading the identified first database record;

passing the first bit pattern from the first database record that had been read to an audio apparatus;

performing, by the audio apparatus, a digital-to-analog conversion of the first bit pattern that had been passed to the audio apparatus;

speaking, by the audio apparatus, the first complete message to the telephone caller, said first complete message consisting of the digital-to-analog converted first bit pattern.”

As indicated in the decision of the Board of Appeals and Interferences (page 4, line 22 - page 5, line 3) on February 21, 2007, Osder’s voice prompt that is spoken at runtime is assembled by inserting dynamic data (e.g., from Table 5 of Osder) into a template (e.g., from Table 3 of Osder) having static elements and missing portions, wherein the dynamic elements are inserted into the missing portions of the template to generate the final assembled voice prompt. See also, Osder, col. 1, lines 48-57 which recites: “A prompt is composed of and defined by a sequence of static and dynamic elements. A static element denotes a fixed phrase, whereas a dynamic element provides a location in the prompt for variable data to be provided by the Network Application at run time. For example, in the prompt "you have <number> new messages", the phrases "you have" and "new messages" are static elements whereas <number> is a dynamic element to be provided by the Network Application in accordance with the conditions at run time.”

Osder does not teach omission of the preceding “assembling step” of assembling the runtime voice prompt by inserting the dynamic data into the template having the static elements and the missing data. Therefore, by being required to perform said “assembling step” which is not a step in the claimed first process, Osder does not teach performing the claimed first process consisting of the steps of: the recited step of reading, the recited step of passing the first bit pattern, the recited step of performing the a digital-to-analog conversion, and the recited step of speaking, the first complete message to the telephone caller. Accordingly, Osder does not anticipate claim 9.

Furthermore, by being required to perform said “assembling step”, it is logically impossible for Osder to teach that the content of the first complete spoken message at runtime consists of the digital-to-analog converted first bit pattern existing in the first database record, as recited in claim 9.

In other words, Osder’s voice prompt that is spoken at runtime is generated by the “assembling step” from two distinct bit patterns located in different database records, namely first bit pattern consisting of a static element located in one portion of a database and a second bit pattern consisting of a dynamic element located in another portion of the database. The Examiner has acknowledged that the static and dynamic elements are stored in separate tables, namely Tables 3 and 5, respectively, and therefore do not collectively constitute a bit pattern that is stored in the first database record.

The Examiner’s new argument in “Response to Arguments” that “it is noted that Osder states that every static and dynamic element of a SPIN application is recorded in the cache element table 80 (col. 10, lines 6-9; see, fig 5A)” is not persuasive, because Osder, FIG. 5A does

not teach that the bits of the static and dynamic elements of the first complete spoken message are stored together contiguously as sequence of bits. For example Osder, FIG. 5A explicitly depicts the static sub-components “YOU HAVE” and “NEW MESSAGES” as being stored non-contiguously with respect to each other and does not depict the dynamic component (e.g., “FIVE”) as being stored contiguously with respect to the static components of “YOU HAVE” and “NEW MESSAGES” in the required contiguous sequence of “YOU HAVE” “FIVE” “NEW MESSAGES”

Moreover, using the Examiner’s example of “you have five new messages”, Osder does not teach the step of “speaking, by the audio apparatus, a first complete message to the telephone caller, said first complete message consisting of the digital-to-analog converted first bit pattern”. In this example, the first complete message spoken to the telephone caller (“you have five new messages”) is not the result of a digital-to-analog conversion of a first bit pattern such that the first bit pattern consists of a contiguous sequence of bits, wherein the bits of the first sequence of bits are stored contiguously in the first database record prior to the digital-to-analog conversion. The spoken complete message is the result of converting three distinct bit patterns (“you have”, “five”, and “new messages”) which do not collectively constitute a sequence of bits stored contiguously in a first database record prior to the digital-to-analog conversion. Osder teaches that the bits of the bit pattern “you have” is stored contiguously. Osder teaches that the bits of the bit pattern “five” is stored contiguously. Osder teaches that the bits of the bit pattern “new messages” is stored contiguously. However, Osder does not teach that the bits of the bit pattern “you have five new messages” is stored contiguously in a first database record prior to the digital-to-analog conversion, as required by claim 9.

Therefore, Osder does not teach the preceding feature of claim 9.

Based on the preceding arguments, Applicant respectfully maintains that Osder does not anticipate claim 9, and that claim 9 is in condition for allowance. Since claims 18-20 depend from claim 9, Applicant contends that claims 18-20 are likewise in condition for allowance.

In addition with respect to claim 18, Osder does not teach the feature:

“identifying a second database record that includes a digitally encoded voice prompt consisting of a second bit pattern that consists of a second sequence of bits wherein the bits of the second sequence of bits are stored contiguously in the identified second database record, and wherein the second bit pattern differs from the first bit pattern, and wherein said identifying the second database record is implemented through use of the second value which selects the second database record and specifies the second bit pattern;

performing a second process that generates a second complete message from the identified second database record and speaks the generated second complete message to the telephone caller, said performing the second process consisting of the steps of:

reading the second database record;

passing the second bit pattern from the second database record that had been read to the audio apparatus;

performing, by the audio apparatus, a digital-to-analog conversion of the second bit pattern that had been passed to the audio apparatus; and

speaking, by the audio apparatus, a second complete message to the telephone caller, said second complete message consisting of the digital-to-analog converted second bit pattern.”

As indicated in the decision of the Board of Appeals and Interferences (page 4, line 22 -

page 5, line 3) on February 21, 2007, Osder's voice prompt that is spoken at runtime is assembled by inserting dynamic data (e.g., from Table 5 of Osder) into a template (e.g., from Table 3 of Osder) having static elements and missing portions, wherein the dynamic elements are inserted into the missing portions of the template to generate the final assembled voice prompt. See also, Osder, col. 1, lines 48-57 which recites: "A prompt is composed of and defined by a sequence of static and dynamic elements. A static element denotes a fixed phrase, whereas a dynamic element provides a location in the prompt for variable data to be provided by the Network Application at run time. For example, in the prompt "you have <number> new messages", the phrases "you have" and "new messages" are static elements whereas <number> is a dynamic element to be provided by the Network Application in accordance with the conditions at run time."

Osder does not teach omission of the preceding "assembling step" of assembling the runtime voice prompt by inserting the dynamic data into the template having the static elements and the missing data. Therefore, by being required to perform said "assembling step" which is not a step in the claimed second process, Osder does not teach performing the claimed second process consisting of the steps of: the recited step of reading, the recited step of passing the second bit pattern, the recited step of performing the a digital-to-analog conversion, and the recited step of speaking, the second complete message to the telephone caller. Accordingly, Osder does not anticipate claim 18.

Furthermore, by being required to perform said "assembling step", it is logically impossible for Osder to teach that the content of the second complete spoken message at runtime consists of the digital-to-analog converted second bit pattern existing in the second database

record, as recited in claim 18.

In other words, Osder's voice prompt that is spoken at runtime is generated by the "assembling step" from two distinct bit patterns located in different database records, namely second bit pattern consisting of a static element located in one portion of a database and a second bit pattern consisting of a dynamic element located in another portion of the database. The Examiner has acknowledged that the static and dynamic elements are stored in separate tables, namely Tables 3 and 5, respectively, and therefore do not collectively constitute a bit pattern that is stored in the second database record.

The Examiner's new argument in "Response to Arguments" that "it is noted that Osder states that every static and dynamic element of a SPIN application is recorded in the cache element table 80 (col. 10, lines 6-9; see, fig 5A)" is not persuasive, because Osder, FIG. 5A does not teach that the bits of the static and dynamic elements of the second complete spoken message are stored together contiguously as sequence of bits. For example Osder, FIG. 5A explicitly depicts the static sub-components "YOU HAVE" and "NEW MESSAGES" as being stored non-contiguously with respect to each other and does not depict the dynamic component (e.g., "FIVE") as being stored contiguously with respect to the static components of "YOU HAVE" and "NEW MESSAGES" in the required contiguous sequence of "YOU HAVE" "FIVE" "NEW MESSAGES"

Moreover, using the Examiner's example of "you have five new messages", Osder does not teach the step of "speaking, by the audio apparatus, a second complete message to the telephone caller, said second complete message consisting of the digital-to-analog converted second bit pattern". In this example, the second complete message spoken to the telephone caller

(“you have five new messages”) is not the result of a digital-to-analog conversion of a second bit pattern such that the second bit pattern consists of a contiguous sequence of bits, wherein the bits of the second sequence of bits are stored contiguously in the second database record prior to the digital-to-analog conversion. The spoken complete message is the result of converting three distinct bit patterns (“you have”, “five”, and “new messages”) which do not collectively constitute a sequence of bits stored contiguously in a second database record prior to the digital-to-analog conversion. Osder teaches that the bits of the bit pattern “you have” is stored contiguously. Osder teaches that the bits of the bit pattern “five” is stored contiguously. Osder teaches that the bits of the bit pattern “new messages” is stored contiguously. However, Osder does not teach that the bits of the bit pattern “you have five new messages” is stored contiguously in a second database record prior to the digital-to-analog conversion, as required by claim 18.

Therefore, Osder does not teach the preceding feature of claim 18.

In addition with respect to claim 20, Osder does not teach the feature: “wherein said replacing the first value with the second value by the IVR system administrator does not comprises using special IVR programming skill to replace the first value with the second value”.

The Examiner argues: “Osder further discloses: wherein said replacing the first value with the second value by the IVR system administrator does not comprises using special IVR programming skill to replace the first value with the second value (i.e. col. 3 lines 64- col. 4 lines 1-5, 33-37).”

In response, Applicant respectfully contends that the preceding citations to Osder do not teach that the IVR system administrator does not use special IVR programming skill to replace

the first value with the second value. Therefore, the Examiner's argument is not persuasive.

In "Response to Arguments", the Examiner states: "No "special IVR programming skill" is required to use the SPIN screen."

In response, Applicant asserts that the Examiner has not provided evidence to support the Examiner's preceding statement that : "No "special IVR programming skill" is required to use the SPIN screen."

Accordingly, Osder does not teach the preceding feature of claim 20.

35 U.S.C. § 103(a)

The Examiner rejected claims 14, 15, 17 and 22-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as “Osder.”

Since claims 14-15 and 17 depend from claim 9, which Applicant has argued *supra* to be patentable under 35 U.S.C. §102(b) over Osder, Applicants maintain that claims 14-15 and 17 are likewise not unpatentable under 35 U.S.C. §103(a) over Osder.

In addition with respect to claims 14-15, the decision of the Board of Appeals and Interferences (page 7, line 24 - page 8, line 7) on February 21, 2007 recites: “We will sustain the Examiner's rejection of claims 3-8 and 11-16. At the outset, we note that specifying the various attributes of voice prompts in these claims merely describes the content of the data stored in the voice prompt database. Because this data content does not further limit the claimed invention either functionally or structurally, it essentially constitutes non-functional descriptive material. Such non-functional descriptive material, however, does not patentably distinguish over prior art that otherwise renders the claims unpatentable. *See In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).”

In light of the preceding analysis by the Board of Appeals and Interferences, Applicants have restructured the language of claims 14-15 in a manner that the recited attributes of the voice prompts do not merely describe the content of the data stored in the voice prompt database, but actually recite the active method steps of speaking the first message. The language of claim 17 has been similarly restructured, as is the language of new claims 22-25. Thus, the language of claims 14-15, 17, and 22-25 comprises functional material in the form of active method steps.

Applicant's analysis *infra* with respect to claims 14-15, 17, and 22-25 will make use of the following two rules of law.

Rule 1. A rejection of a claim on grounds of obviousness requires that all features of the claim are known in the prior art.

An attempt to show that it is obvious to combine elements to disclose the claimed invention starts with elements that are known in the prior art and then seeks to demonstrate that it is obvious to combine the elements. *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) ("When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine **known elements** in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. See *Application of Bergel*, 292 F. 2d 955, 956-957 (1961)") (emphasis added).

Insight as to why all elements of a claim must be known to reject the claim on grounds of obviousness is provided in *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (reversing the Board's rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: "[t]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. **Obviousness cannot be predicated on what is unknown**")." (emphasis added)

Applicant will present arguments *infra* demonstrating that the Examiner's arguments with respect to claims 14-15, 17, and 22-25 has repeatedly rejected claims on grounds of obviousness without demonstrating that all elements of the claim are known in the prior art.

Rule 2. A rejection of a claim on grounds of obviousness though use of a prior art reference or a combination of prior art references requires that the prior art teach enablement for combining subject matter in the prior art references to make and use the claimed invention.

In re Kumar, 76 USPQ2d 1048 (Fed. Cir. 2005) is the current controlling case law regarding the requirement that the prior art must enable claimed subject matter. In *In re Kumar*, the Federal Circuit states: “Although published subject matter is “prior art” for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must **enable** a person of ordinary skill to make and use the invention.... To render **a later invention** unpatentable for obviousness, the prior art must **enable** a person of ordinary skill in the field to make and use the **later invention**.” (emphasis added), *Kumar*, 76 USPQ2d at 1052, 1053.

Appellant will present arguments *infra* demonstrating that the reference used in the Examiner’s argument to reject claims 14-15, 17, and 22-25 on grounds of obviousness does not enable the claimed subject matter.

As to claim 14, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said music”.

The Examiner argues that “Per claim 14: ... Osder does not explicitly teach that the database includes a voice prompt that includes music. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include music voice prompts as callers may have different preferences and purposes. The

modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 14. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is **unknown** in the prior art. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 14.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 14, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teaches how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are music. Therefore, there is a lack of enablement for including dynamic elements within a template of static elements when the static and dynamic elements are music, and the enablement required of the cited prior art reference as set forth in *In re Kumar* (as discussed *supra*) is not satisfied. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 14.

Accordingly, claim 14 is not unpatentable under 35 U.S.C. §103(a) over Osder.

As to claim 15, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of an audio tone, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said audio tone”.

The Examiner argues that “Per claim 15: ... Osder does not explicitly teach that the database includes a voice prompt that includes an audio tone. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include audio tone of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art ”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 15. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is **unknown** in the prior art. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 15.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 15, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teaches how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior

art of how to include dynamic elements within a template of static elements when the static and dynamic elements are said audio tone. Therefore, there is a lack of enablement for including dynamic elements within a template of static elements when the static and dynamic elements are said audio tone, and the enablement required of the cited prior art reference as set forth in *In re Kumar* (as discussed *supra*) is not satisfied. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 15.

Accordingly, claim 15 is not unpatentable under 35 U.S.C. §103(a) over Osder.

As to claim 17, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said sequence of beeps”.

The Examiner argues that “Per claim 17: ... Osder does not explicitly teach that the digitally-encoded voice prompt consists of a sequence of beeps. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including beeps as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 17. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566

F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is *unknown* in the prior art. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 17.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 17, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teach how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are a sequence of beeps. Therefore, there is a lack of enablement for including dynamic elements within a template of static elements when the static and dynamic elements are a sequence of beeps, and the enablement required of the cited prior art reference as set forth in *In re Kumar* (as discussed *supra*) is not satisfied. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 17.

Accordingly, claim 17 is not unpatentable under 35 U.S.C. §103(a) over Osder.

As to claim 22, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record is spoken by a first speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a second speaker; herein said speaking the first message comprises

speaking by the first speaker the first message consisting of the digital-to-analog converted first bit pattern; and wherein said speaking the second message comprises speaking by the second speaker the second message consisting of the digital-to-analog converted second bit pattern ”.

The Examiner argues that “Osder does not explicitly teach that the voice prompt pertaining to the first bit pattern in the first database record is spoken by a first speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a second speaker; wherein said speaking the first message comprises speaking by the first speaker the first message ... wherein said speaking the second message comprises speaking by the second speaker the second message consisting of the digital-to-analog converted second bit pattern. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by different speakers as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different purposes.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 22. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is ***unknown*** in the prior art. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 22.

Accordingly, claim 22 is not unpatentable under 35 U.S.C. §103(a) over Osder.

As to claim 23, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record is spoken by a male speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a female speaker; wherein said speaking the first message comprises speaking by the male speaker the first message consisting of the digital-to-analog converted first bit pattern; and wherein said speaking the second message comprises speaking by the female speaker the second message consisting of the digital-to-analog converted second bit pattern”.

The Examiner argues that “Osder does not explicitly teach that the voice prompt pertaining to the first bit pattern in the first database record is spoken by a male speaker; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by a female speaker; wherein said speaking the first message comprises speaking by the male speaker the first message ... wherein said speaking the second message comprises speaking by the female speaker the second message consisting of the digital-to-analog converted second bit pattern. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different voice prompts spoken by male and female speakers as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that

discloses the preceding feature of claim 23. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is ***unknown*** in the prior art. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 23.

Accordingly, claim 23 is not unpatentable under 35 U.S.C. §103(a) over Osder.

As to claim 24, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record has a first level of formality; wherein the voice prompt pertaining to the second bit pattern in the second database record has a second level of formality that differs from the first level of formality; wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern having the first level of formality; and wherein said speaking the second message comprises speaking the second message consisting of the digital-to-analog converted second bit pattern having the second level of formality”.

The Examiner argues that “Osder does not explicitly teach the voice prompt pertaining to the first bit pattern in the first database record has a first level of formality; wherein the voice prompt pertaining to the second bit pattern in the second database record has a second level of formality that differs from the first level of formality; wherein said speaking the first message ...second message consisting of the digital-to-analog converted second bit pattern having the

second level of formality. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include different level of formality of voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 24. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is ***unknown*** in the prior art. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 24.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 24, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teaches how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are different levels of formality. Therefore, there is a lack of enablement for including dynamic elements within a template of static elements when the static and dynamic elements are different levels of formality, and the enablement required of the cited prior art

reference as set forth in *In re Kumar* (as discussed *supra*) is not satisfied. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 24.

Accordingly, claim 24 is not unpatentable under 35 U.S.C. §103(a) over Osder.

As to claim 25, Applicant respectfully contends that Osder does not disclose the feature: “wherein the voice prompt pertaining to the first bit pattern in the first database record is spoken by a speaker in a first wording and conveys a meaning; wherein the voice prompt pertaining to the second bit pattern in the second database record is spoken by the speaker in a second wording that differs from the first wording and conveys said meaning; wherein said speaking the first message comprises speaking by the speaker the first message consisting of the digital-to-analog converted first bit pattern in the first wording that conveys said meaning; and wherein said speaking the second message comprises speaking by the speaker the second message consisting of the digital-to-analog converted second bit pattern in the second wording that conveys said meaning”.

The Examiner argues that “Osder does not explicitly teach that the voice prompt pertaining... spoken by a speaker in a first wording and conveys a meaning...second wording that differs from the first wording and conveys said meaning... in the first wording that conveys said meaning... second bit pattern in the second wording that conveys said meaning. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including a dialect as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt

options for different preferences.”

In response, Applicants note that the Examiner has not cited any prior art reference that discloses the preceding feature of claim 25. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (“Obviousness cannot be predicated on what is unknown”). Applicant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is **unknown** in the prior art. Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claim 25.

Moreover, Applicants assert that it is not obvious to modify Osder to include the preceding feature in claim 25, because of lack of enablement. Osder requires the spoken runtime message to include dynamic elements within a template of static elements, and Osder teaches how to include dynamic elements within a template of static elements only when the static and dynamic elements are words or phrases. The Examiner has not cited any disclosure in the prior art of how to include dynamic elements within a template of static elements when the static and dynamic elements are synthesized with different wording having the same meaning. Therefore, there is a lack of enablement for including dynamic elements within a template of static elements when the static and dynamic elements are synthesized with different wording having the same meaning, and the enablement required of the cited prior art reference as set forth in *In re Kumar* (as discussed *supra*) is not satisfied. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 25.

Accordingly, claim 25 is not unpatentable under 35 U.S.C. §103(a) over Osder.

CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457 (IBM).

Date: 07/28/2008

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